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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/722,516

11/28/2003

Nick Chareas

21819.01

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7590

09/07/2004

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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/722,516	Applicant(s) CHAREAS ET AL	
	Examiner Monica S. Carter	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-4, 6-8, 10-13 and 20 is/are rejected.
 7) ☒ Claim(s) 5 and 9 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/28/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13 and 20, drawn to a writing pad attachment, classified in class 281, subclass 44.
 - II. Claims 14-19, drawn to a cellular phone with a writing pad attachment, classified in class 455, subclass 567.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the writing pad attachment can be releasably attached to other wireless communication devices not limited to a cellular phone. The subcombination has separate utility such as being attached to an electronic notebook.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Dolph H. Torrence on August 31, 2004 a provisional election was made with traverse to prosecute the invention of Group I,

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claims 1-13 and 20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

6. The use of the trademark VELCRO ® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 6-8, 10-13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenstein (3,052,056) in view of Nieradka (5,324,076) and further in view of Wilska et al. (6,427,078).

Eisenstein discloses a telephone accessory comprising a housing (10) releasably mountable (via loops 38 – see column 2, lines 39-48) to a device (telephone), the housing having at least a top surface, at least two closed sides forming an access opening in the housing, and a bottom lip portion disposed along each of the closed sides (as seen in figures 1 and 3); an adjustable support tray (18) slidably disposed in the housing and supported by the bottom lip portions, the support tray having a main body with a top surface (as seen in figure 1), a bottom surface (as seen in figure 4) and a pair of mounting grooves disposed on a first side and a second side of the bottom surface for slidably engaging the bottom lip portions, the support tray being movable between two positions, wherein the two positions include an open position and a closed position (see column 2, lines 49-52); a support tray locking mechanism for releasably locking the support tray in one of the two positions (see column 2, lines 2-9); a marking pad (23) removably disposed in the support tray.

Eisenstein discloses the claimed invention except for the device being a wireless device.

Wilska et al. disclose a wireless communication device (27) having a marking pad (29) removably attached to the device (as seen in figure 7). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to

modify the device of Eisenstein to be a wireless device, as taught by Wilska et al., to provide an easily transportable device.

Eisenstein, as modified by Wilska et al., discloses the claimed invention except for a writing implement removably disposed in the support tray.

Nieradka discloses a portable device having a removable marking pad (2) and a trough (7) for removably receiving a writing implement. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Eisenstein to removably include a writing implement, as taught by Nieradka, to enable the user to easily record information on the removably received marking pad.

Regarding claim 2, Eisenstein, as modified by Wilska et al. and Nieradka, discloses a mounting member (38 of Eisenstein) for releasably mounting the writing pad attachment to the device as disclosed above.

Regarding claim 3, Eisenstein, as modified by Wilska et al. and Nieradka, discloses the mounting member being disposed along the top surface of the housing for securing the housing to rear portion of the device (as seen in figure 1 of Eisenstein).

Regarding claim 4, Eisenstein, as modified by Wilska et al. and Nieradka, discloses the claimed invention except that a loop (38) instead of double-sided adhesive tape is used for the mounting member. Eisenstein, as modified by Wilska et al. and Nieradka, shows that a loop (38) is an equivalent structure known in the art. Therefore, because these two fasteners were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute double-sided adhesive tape for the loop.

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Regarding claim 6, Eisenstein, as modified by Wilska et al. and Nieradka, discloses the housing and the support tray being fabricated from a lightweight material (as seen in column 2, lines 58-60 of Eisenstein).

Regarding claims 7 and 8, see the above rejections to claim 1.

Regarding claim 10, see the above rejections to claim 1. The support tray is removed from the housing as seen in figure 1 of Eisenstein.

Regarding claim 11, Eisenstein, as modified by Wilska et al. and Nieradka, discloses the marking pad and the writing implement being concealed in the housing when the supporting surface is in the closed position (as seen in figure 3 of Eisenstein).

Regarding claim 13, Eisenstein, as modified by Wilska et al. and Nieradka, discloses the marking pad being a pad of paper and the writing implement being a pen as set forth above.

Regarding claim 20, Eisenstein, as modified by Wilska et al. and Nieradka, discloses the writing pad attachment as set forth in the above rejections.

Allowable Subject Matter

9. Claims 5 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

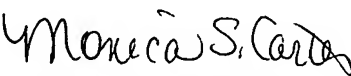
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose writing pad attachments.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 3, 2004


MONICA S. CARTER
PRIMARY EXAMINER